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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARRY W. MORRIS, DAVID LOWELL LIPPKE,
BOB WATKINS, ERIC BOSCO, and COLIN STEELE

Appeal 2009-011419
Application 09/690,007
Technology Center 2400

Decided: May 4, 2010

Before ROBERT E. NAPPI, ELENI MANTIS MERCADER, and
BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-28, 55-57, and 64-75. Claims 29-54 and 58-63 have been canceled. Oral arguments were held on April 20, 2010. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse. Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection under 35 U.S.C. § 112, ¶ 2.

STATEMENT OF THE CASE

Appellants' invention relates to "[a] method of presenting advertising to viewers in a computer network environment [that] includes monitoring a viewer's interactions with an associated computer system, and adjusting a timing of displayed advertisements on the viewer's associated computer system based on one or more of the viewer's monitored interactions" (Abstract). The monitoring of the viewer's interactions may include (1) monitoring whether the window displaying the advertisements is maximized, minimized, or at least partially occluded; or (2) monitoring the viewer's use of an input device, such as a keyboard, mouse, or microphone (Spec. 8).

Tuning parameters, which are also downloaded to the user's computer, are used to monitor the viewer's interactions with the computer (Spec. 8). The tuning parameters are used to adjust the length of time that each advertisement is displayed before being replaced with a subsequently displayed advertisement (Spec. 7-9). Various tuning parameters include (1) "a maximum display count that sets a maximum number of times an advertisement may be displayed to a user viewing a batch of ads;" (2) "a minimum display time that sets a minimum amount of time that an advertisement may be displayed before another advertisement is displayed;"

(3) "an idle delay that causes a delay from the time a user has gone idle before a first advertisement is replaced with another advertisement;" (4) "an active delay that causes a delay from the time a user goes active before displaying another advertisement;" and (5) "an idle (no spin) timer that stops the display of a first advertisement from being replaced with the display of another advertisement after a user goes idle for so long that is it [sic: it is] unlikely that the user is actually looking at the screen" (Spec. 8).

The "click through rate" can also be monitored to generate statistics regarding "[t]he rate at which users click on an ad to go to the linked ad" (Spec. 14). The statistics can indicate for a particular computer user, "the likelihood of click through relative to, for example, the amount of time that an ad is displayed or the amount of time that the user is idle before the ad is displayed. These statistics can be used to control ad timing in ways that improve click-through rates" (Spec. 14). For example, the statistics can "be used to determine a correlation between the tuning parameters downloaded to the user's computer and the click-through rate of the user" (Spec. 9). The tuning parameters may then be customized and varied with each batch of advertisements that is downloaded to the user's computer in order to optimize the effectiveness of an internet-advertisement marketing campaign (Spec. 9-11, 14-15; Figs. 17 and 24).

Claims 1-28, 55-57, and 64-75 stand rejected under 35 U.S.C. § 103(a) as obvious over US Patent 6,108,637 [Blumenau] in view of US Patents 6,119,098 [Guyot] and 6,128,651 [Cezar]. We understand the Examiner's position to be that the combination of Blumenau, Guyot, and Cezar teaches an internet advertising system that varies the length/duration

of advertisements based on a viewer's prior interaction with a computer for the purpose of tailoring advertisements to a particular user (e.g., Ans. 3-6).[1]

> Appellants conversely assert *inter alia*:
>
> [N]one of the cited references describe or suggest varying an amount of display time for which a later displayed advertisement is to be displayed on a viewer's associated computer system based on any monitored information, much less the viewer's monitored interactions with the viewer's associated computer system. . . . [In the portion of Blumenau relied upon by the Examiner], the amount of display time for a later advertisement is not varied based on the monitored information. Rather, the amount of time the content has already been displayed is determined based on such information.

Reply Br. 2.

Before considering the prior-art rejections or Appellants' arguments, though, we must first determine the scope of the claims. *In re Geerdes*, 491 F.2d 1260, 1262 (CCPA 1974). This investigation leads us to conclude that one of ordinary skill in the art cannot reasonably ascertain the metes and bounds of the pending claims. Pursuant to our authority under 37 C.F.R. § 41.50(b), then, we now enter a new ground of rejection under 35 U.S.C. § 112, ¶ 2. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.,* 806 F.2d 1565, 1576 (Fed. Cir. 1986) (noting that the test for definiteness under 35 U.S.C. § 112, ¶ 2, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification") (citations omitted).

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[1] Rather than repeat the Examiner's positions or Appellants' arguments in their entirety, we refer to the following documents throughout this opinion for their respective details: (1) the Appeal Brief ("App. Br.") filed December 1, 2008; (2) the Examiner's Answer ("Ans.") mailed February 12, 2009; and (3) the Reply Brief ("Reply Br.") filed April 13, 2009.

ANALYSIS

Independent claim 1 is illustrative, reading as follows:

> 1. A method of presenting advertising to viewers in a computer network environment, the method comprising:
>
> monitoring a viewer's interactions with an associated computer system;
>
> determining an amount of time to be used in later displaying advertisements on the viewer's associated computer system based on the viewer's monitored interactions; and
>
> based on the determined amount of time, varying an amount of display time for which a later displayed advertisement is to be displayed on the viewer's associated computer system, the varied amount of display time being different than an amount of display time for which the later displayed advertisement is to be displayed on another viewer's associated computer system.

It is not reasonably clear what is meant by the claim language, "based on the determined amount of time, varying an amount of display time for which a later displayed advertisement is to be displayed on the viewer's associated computer system." Nor is it reasonably clear what relationship is intended for the two claimed times: "the *determined* amount of time" (limitation 2 (emphasis added)) and "the *varied* amount of display time" (limitation 3 (emphasis added)). The third limitation states that "*an* amount of time" (as opposed to "*the* amount of time") is varied "based on *the* determined amount of time" (emphases added). These antecedent bases seem to indicate that the "varied amount of time" is some time period that is distinct from, and occurring subsequent to, the

"determined time period." However, if this is so, it would beg the question: relative to what time period is the "varied amount of display time" varied? The claim does not provide any objective baseline standard.

This ambiguity can be described another way. It is unclear whether the third limitation's language, "*based on* the determined amount of time, varying an amount of display time" (emphasis added) means (1) varying an amount of display time *relative to* the determined amount of time or (2) varying an amount of display time *as a function of* the determined amount of time. Under the first interpretation, the determined amount of time is a base used to implement the varied amount of time, without being used itself. Under the second interpretation, the determined amount of time is first used in the claimed monitoring process, and the varied amount of time is later used in the process.

The first interpretation does not seem reasonable because the act of "determining an amount of time to be used" is, in turn, "based on the viewer's monitored interactions." This implies that the "determining" step occurs subsequent to the monitoring, and that this step does not correspond to merely setting initial download parameters prior to any interactions being monitored.

Conversely though, the second interpretation is not supported by the Specification. The Specification nowhere discloses varying an amount of display time as a function of a time to be used in later displaying advertisements. Rather, the Specification discloses correlating or varying the tuning parameters as a function a user's monitored interactions (e.g., Spec. 9-10).

This ambiguity is compounded by the fact that claim 1 recites "determining an amount of time to be used *in later displaying advertisements*. . .;" and then "varying an amount of display time for which *a later displayed advertisement* is to be displayed. . ." (emphases added). It is not reasonably clear whether the latter limitation is actually intended to mean, "varying an amount of display time for which a [sic: one of the] *later displayed advertisement* is to be displayed." That is, it is not reasonably clear whether (1) the later displayed advertisement that has the varied amount of display time (limitation 3) is one of the advertisements that is referenced in the second limitation, "determining an amount of time to be used in later displaying advertisements," or (2) the later displayed advertisement having a varied amount of display time is an advertisement that is displayed even later relative to "the later displaying advertisements" of the second limitation.

The ambiguities of claim 1 are not clarified by the dependent claims. Various dependent claims (e.g., claims 2, 3, 6, and 7) recite that the method of claim 1 *further comprises* adjusting various tuning parameters. That is, these claims do not state that the "determining" or "varying" steps of claim 1 more specifically comprise adjusting the tuning parameters. Claim 4 does recite that the "varying" step of claim 1 comprises adjusting one of the tuning parameters, but none of the dependent claims further clarifies what the "determining" step is intended to correspond to. As such, the dependent claims do not help clarify the intended relationship between the "determining" and "varying" steps.[2]

[2] Claim 5 recites "The method of claim 1, *wherein further comprising* adjusting an idle delay…" (emphasis added). As such, it is unclear what

The ambiguities of claim 1 are not clarified by Appellants' Appeal Brief either. Appellants state that the act of determining an amount of time to be used in later displaying advertisements is supported by the Specification "at page 7, line 19 though page 8, line 3, page 8, lines 6-8, page 10, line 20 through page 11, line 6, page 14, lines 12-18, page 15, lines 1-14, page 18, lines 1-10, page 20, lines 17-21, and page 29, line 8 through page 31, line 4" (App. Br. 1-2). These cited portions of the Specification relate to disclosure of the various tuning parameters as well as disclosure of how to adjust the tuning parameters.

Appellants then state, though, that claim 1's following step of varying an amount of display time is also supported by the Specification

> at page 7, line 20 though page 8, line 3, page 8, lines 6-8, page 9, line 20 through page 10, line 14, page 10, line 20 through page 11, line 6, page 14, lines 12-18, page 15, lines 1-14, page 18, lines 1-10, page 20, lines 17-21, and page 29, line 8 through page 31, line 4.

(App. Br. 2). That is, Appellants cite to large and substantially identical portions of the Specification for support of both "the determined amount of time" limitation and "the varied amount of display time" limitation. As such, the Appeal Brief does not clarify what the difference or relationship between these two steps is intended to be.

The ambiguities are not clarified by the Specification. For example, it is unclear whether the step of "determining an amount of time to be used in later displaying advertisements" is intended to correspond to the act of determining whether a user is active for the purpose of setting the status to

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claim 5 means – how claim 5 is intended to relate to claim 1. Much less does claim 5 clarify the ambiguities existing in claim 1.

either active or idle (Spec. 20; Fig. 15, step 1015). Alternatively, the determining step may be intended to correspond to either (1) storing tuning on a host computer (e.g., Fig. 24, step 1310), or perhaps (2) downloading an initial set of the stored tuning parameters to a user's computer (e.g., Fig 24, step 1315).

Finally, the ambiguities of claim 1 are not clarified by any of the other independent claims either. Independent claim 15 is directed to a computer-readable medium storing a program that similarly comprises "a monitoring code segment," "a determining code segment," and "an adjusting code segment." Independent claim 75 recites a method similar to claim 1 that includes determining an amount of time, and also accessing and adjusting general timing attributes that indicate an amount of time to display advertisements based on the determined amount of time.

Independent claim 55 recites a method of optimizing a click-through rate that includes:

> downloading advertisements and a set of tuning parameters to a user's computer, wherein the set of *tuning parameters are configured to cause* a display of a first advertisement on the user's computer to be changed to a display of another advertisement on the user's computer by *varying an amount of display time* for which the *later* displayed advertisement is to be displayed based on a user's activity with respect to the user's computer. . .

(emphases added). At first blush, the metes and bounds of claim 55 seem to be generally ascertainable.[3] However, the plain language of claim 55 is not supported by Appellants' Specification. The claim language seems to set

[3] We provisionally interpret the term "the later displayed advertisement" as intending to refer back to the claimed "another advertisement" as distinguished from the claimed "a first advertisement."

forth that the length of the *later* advertisement is varied as a function of the tuning parameter configuration. However, the Specification indicates that a user's actions, as monitored by the tuning parameters, affect the length of time an *initial* advertisement is presently displayed before a later advertisement is displayed (e.g., Spec. 7-11) – not the length of time the *later* advertisement itself is displayed. The fact that the most plausible interpretation is not supported by the Specification seems to imply that some alternative, but unascertainable, interpretation is intended. Moreover, claim 55 does not resolve the ambiguities that exist with the other independent claims.

For the foregoing reasons then, we find claims 1-28, 55-57, and 64-75 to be indefinite under 35 U.S.C. § 112 ¶ 2. *See Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential), *available at http://www.uspto.gov/web/offices/dcom/bpai/prec/fd073300.pdf* (holding that "if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite").

Regarding the outstanding obviousness rejection, we note that a prior art rejection of a claim, which is so indefinite that "considerable speculation as to [the] meaning of the terms employed and assumptions as to the scope of such claims" is needed, is likely imprudent. *See In re Steele*, 305 F.2d 859, 862, 134 USPQ 292 (CCPA 1962) (also holding that the Examiner and the Board of Patent Appeals were wrong in relying on what at best were speculative assumptions as to the meaning of the claims and basing a rejection under 35 U.S.C. § 103 thereon). Accordingly, we reverse the

Examiner's rejection of claims 1-28, 55-57, and 64-75 under 35 U.S.C. § 103 without reaching the merits of that rejection.

DECISION

The Examiner's decision rejecting claims 1-28, 55-57, and 64-75 under 35 U.S.C. § 103 is reversed.

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection under 35 U.S.C. § 112, ¶ 2.

FINALITY OF DECISION

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). This regulation states that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." Furthermore, 37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection,

the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED
37 C.F.R. § 41.50(b)

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